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EXAMINER

COHEN, C

ART UNIT

PAPER NUMBER

3634

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/839,161

Applicant(s)
Newton et al

Examiner
Curtis Cohen

Group Art Unit
3634



☒ Responsive to communication(s) filed on Sep 3, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-90 is/are pending in the application.

Of the above, claim(s) 26-28 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-25 and 29-90 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 29, 30, 32-34, 39-44, 46-48 and 53-58, 60-63, 67-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Haas. Haas teaches that it is known in the art to provide a sash with sash support arms 152 that hang freely downward engage the sash shoes 112 thereby placing the weight of the sash on the shoes. A pivotally mounted locking means 92 mounted on a pin in a pin groove (or slot) on a sash shoe 65 which is adapted to lockingly engage the partition walls, see column 3, lines 15-22. A spring latch 102 retains the hook in an undeployed position and it is capable of being manually moved or moved with a tool. A guide 64 is mounted on the shoe 65.

Claims 74, 75, 79-81, 85, 86 and 90 are rejected under 35 U.S.C. 102(b) as being anticipated by Osten, Sr. #2,987,758. Osten, Sr. teaches a movable sash 20 mounted in a window frame 12 having sash guides 14. Sash support arms 50 are pivotally mounted on a pivot 44 between an outwardly and a downwardly extending position. The arms 50 rest on a pair of sash shoes 92 as best shown in Figure 1. In the inwardly extending position, the arms can touch an outer region of the shoe, and in the outwardly extending position the arms can touch the inner

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region of the shoe. A counterbalance is applied to a hook region which is above the outer platform region of the shoe. A locking element is taught by the surface 102. In column 2, lines 1-6, Osten, Sr. discloses that it is known to use extrusion as a manufacturing technique. The shoe of Osten, Sr. also comprises a guide 110 which guides the shoe and window along a track 114. A retaining groove is taught by the eyelet of hook 84.

Claims 76, 77, 78, 82-84 and 87-89 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Osten, Sr. Osten, Sr. teaches the invention as discussed in the rejection above. Osten, Sr. appears to disclose in the Figures a window assembly that is the same as applicants' invention. Nevertheless, if the specific size of the window is not clear, it is readily apparent that one of ordinary skill would make shoes and the arms to fit whatever size window for which they are installed as a matter of design choice. This is merely the application of the expected skill of one of ordinary skill in the art. Accordingly, it would have been obvious to one having ordinary skill in the art, at the time of applicants' invention, to make the shoes of Haas any size necessary to fit a particular application. It should be noted that applicants' claims do not define a particular structural feature that would distinguish from Osten, Sr.

Claims 31, 49-51, and 64-66 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haas. Haas teaches the invention as discussed in the rejection above. Haas appears to teach the same size metal shoe member that applicants have set forth. However, if the disclosure of Haas is unclear whether as to the specific

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size of metal used, it is readily apparent that one of ordinary skill would make shoes and the arms to fit whatever size window for which they are installed as a matter of design choice. This is merely the application of the expected skill of one of ordinary skill in the art. Accordingly, it would have been obvious to one having ordinary skill in the art, at the time of applicants' invention, to provide Haas with the same size metal shoe member as the channel member.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten, Sr.

Osten, Sr. teaches a movable sash 20 mounted in a window frame 12 having sash guides 14. Sash support arms 50 are pivotally mounted on a pivot 44 between an outwardly and a downwardly extending position. The arms 50 rest on a pair of sash shoes 92 as best shown in Figure 1. In the inwardly extending position, the arms can touch an outer region of the shoe, and in the outwardly extending position the arms can touch the inner region of the shoe. A counterbalance is applied to a hook region which is above the outer platform region of the shoe. A locking element is taught by the surface 102. In column 2, lines 1-6, Osten, Sr. discloses that it is known to use extrusion as a manufacturing technique. Claim 12, the preamble of this claim indicates a Jepson type claim

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where the structure indicated in the preamble of the claim is admitted prior art. Therefore, the burden of the examiner is to provide evidence of the subcombination of the structure listed in sections a-c of claim 12. However, Osten, Sr. meets the requirements for a 102(b) by teaching all of the limitations in the preamble and the limitations in sections a-c. The shoe of Osten, Sr. also comprises a guide 110 which guides the shoe and window along a track 114. A retaining groove is taught by the eyelet of hook 84. Although Osten, Sr. does teach that extrusion is well known and he teaches that the shoes can be made from a sintered power, it would have been an obvious matter of design choice to have made the shoes from an extrusion process which is a more economical and time efficient method of making the shoes. Osten, Sr. does not disclose to what particular dimension the metal is intended to be sized. However, applicants' claims do not define a particular structural feature that would distinguish from Osten, Sr. Nevertheless, it would have been obvious to one of ordinary skill in the art to make shoes and the arms to fit whatever size window for which they are installed.

Claims 35-38 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haas as applied to claims 1-11, 29, 30, 32-34, 39-44, 46-48 and 61-63, 53-58, 60, 67-73 above, and in further view of Osten, Sr. Haas discloses the invention as taught in the Section 102 rejection above including a locking slot 96. Haas does not disclose the shoe 64 being formed of a resin material. Osten, Sr. teaches that it is known in the art to form a shoe guide 110 out of a resin material as described on column 3, lines 45-49, to reduce the frictional noise created by the known metal guides when they contact the metal channels. For this reason, it would have been

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obvious to one having ordinary skill in the art at the time of applicants' invention, to provide Haas with a guide formed from a resin material as taught by Osten, Sr.

Claims 59 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osten, Sr. Osten, Sr. teaches the invention as discussed in the Section 102(b) rejection above. Osten, Sr. lacks a support arm having extruded coding lines indicating the length of the support arm. Coding symbols are well known in the art of manufacturing per se. One example of this teaching is on the head of a bolt which has different coding lines indicating the different strengths of each bolt. Therefore, it would have been obvious to one having ordinary skill in the art, at the time of applicants' invention, to provide Osten, Sr. with code lines to indicate the length of the arm.

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haas as applied to claims 31, 49-51, and 64-66 above. Haas teaches the invention as discussed in the Section 102(b)/103 rejection above. Haas lacks a support arm having extruded coding lines indicating the length of the support arm. Coding symbols are well known in the art of manufacturing per se. One example of this teaching is on the head of a bolt which has different coding lines indicating the different strengths of each bolt. Therefore, it would have been obvious to one having ordinary skill in the art, at the time of applicants' invention, to provide Haas with code lines to indicate the length of the arm.

Response to Arguments

Applicants' arguments filed September 13, 1999 have been fully considered but they are not persuasive.

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In response to applicants' arguments on page 4 of the amendment that the support arms of Haas do not hang freely, it is believed that the support arms do hang freely downward even though they are coupled to a spring. There appears to be a difference in the interpretation of the relative phrase "hang freely." The examiner considers the elongated support arms of Haas to be hanging freely because the support arms are pivotally supported at one end and the other end is capable of pivoting downward, i.e., "free" to move downward. Forces that resist moving the support arm, such as the spring or internal friction of the pivot pin, do not detract from the support arm hanging freely. Apparently, applicants are relying on the specification to impart limitations to the claim limitations not recited therein. This reliance is ineffective.

Applicants argue that the lock 92 of Haas engages a smooth partition wall, not a projection formed in the jamb wall as claimed. Applicants further argue that the lock is not hook-shaped, rather it is rectangular. It is not clear to which claims applicants are referring. Nevertheless, it is clear from column 2, lines 47 and 48, that the "U-shaped locking member" is clearly not rectangular. This point of argument is perplexing because applicants refer to the "rectangular" member as a "U-shaped locking detent 92" on page 8, line 11 of this amendment. The examiner believes that "U-shaped" and "hook-shaped" are synonymous. Furthermore, it is believed that the locks 92 engage the side wall of the channels and they engage the sash shoe 112.

Applicants argue that in the fourth paragraph on page 4 that the locks 92 of Haas do not hang downwardly and are not below the shoes as claimed. First, the term "downwardly" is a relative term and which must be referenced with another element of the claim for it to be given

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weight. That is, one could consider the support arms in applicants' Figures 1 and 2 to be hanging "downwardly" with respect to the position of the support arms in applicants' Figure 3.

Nevertheless, it is the examiner's position that the support arms of Haas hang "downwardly" when they are pushed downwardly. Furthermore, applicants' have not set forth a point of reference, therefore, the term "downward" is used to establish one given direction or position. For the term "downward" to be interpreted as applicants are intending, then applicants might want to consider establishing a point of reference.

Applicants argue that the spring does not retain the lock in an undeployed position but biases it constantly into a deployed position. It is not clear to which claim, or claim language, to which applicant is arguing. It is not readily apparent to the examiner where the "deployed" position and the "undeployed" position is defined. It appears as though applicants' arguments are not commensurate with the scope of the claims since it is not clear what language in applicants' claimed invention sets forth a "deployed" and "undeployed" position. Therefore, it is believed that the invention to Haas remains proper as an anticipatory teaching of the claimed invention.

Applicants have set forth many allegations that Haas does not teach certain aspects of the "claimed invention" without pointing out the language recited in the claims. With such a numerous amount of claims, it is not clear where this language exists. The examiner has reviewed all of the claims, and the allegations that Haas does not teach certain elements of the claims, does not appear to be founded in fact.

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In response to applicants' arguments that the guide 64 of Haas differs from the guides defined in claims 36 and 46, it is believed that the guides 64 meet the limitations of the claims as currently set forth. Moreover, applicants' arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to applicants' arguments set forth in the second paragraph on page 5 of the amendment, it is not clear what language applicants have recited in the claims which is not taught by Osten, Sr. Applicants' arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicants argue that the support arms of Osten do not hang downward. As stated in the response above, the term "downward" is a relative term and is given little patentable weight other than to define one given direction.

Applicants argue that Osten, Sr.'s suggested shape for the shoe and sash support arms is inconsistent with extrusion as a way of making such elements. Osten, Sr. teaches that it is known to use the extrusion process as one way of manufacturing portions of the window. To make other pieces of the window, not particularly pointed out as being made from extrusion, from that same process, is obvious as stated in the rejection. In a product by process claim, it is the patentability of the product being made, and not its recited process steps, that is to be determined. Why is the

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shape of the shoe in Osten precluded from being extruded. Applicants have supplied no reasons, except for the broad allegation, as to why these pieces cannot be made from an extrusion process. Furthermore, what is the relationship between the shape of applicants' invention and the extrusion process? Why can applicants' elements be extruded and Osten, Sr.'s cannot? Where in the claims has applicant recited the geometrical configuration of the elements that permits one to manufacture certain elements of the invention using the extrusion process?

Similarly, applicants argue that the shoe parts and the sash support arms of Haas cannot be made from an extrusion process. The examiner refers to the remarks in the preceding paragraph for a response to this point of dispute.

In the middle of page 8, applicants appear to be arguing that, just because one part of Haas is made from a resin, it is not obvious to make other parts from resin. Applicants have stated that other parts of the invention cannot be made from resin. However, applicants have supplied no reason why the other parts cannot be constructed from resin. Applicants appear to be arguing that Haas does not anticipate 35-38 and 45. That is, applicants seem to be arguing nonanticipatory, rather than nonobviousness. The rejection states that it would have been obvious, in view of Osten, Sr., that it is known to make components from a resinous material, to make the guide from a resinous material for the purpose of reducing frictional noises.

Applicants argue on the bottom of page 8 that although other forms of size coding are known for various elements such as bolts, an ordinary worker following the teaching of Osten, Sr. would not be led to use extrude coding lines indicating differing lengths. First, applicants' use of

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the term "ordinary worker" is interpreted by the examiner as "one having ordinary skill." Even though this term does not convey such a meaning, it is believed that this was applicants' intent. Nevertheless, one of ordinary skill would have known to place indicators on the pieces to identify them based on particular physical characteristics.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Cohen whose telephone number is (703) 308-2106.

The fax phone number for this Group is (703) 305-7687.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

C. Cohen *u*

November 18, 1999

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is written in a cursive style with a large initial 'D'.

Daniel P. Stodola
Supervisory Patent Examiner
Group 3600